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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,852	02/23/2004	Takahiro Goto	Q79959	5491
23373 7590 07/11/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
EOFF, ANCA				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
07/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/782,852

**Applicant(s)**

GOTO, TAKAHIRO

**Examiner**

ANCA EOOF

**Art Unit**

1795

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 10, 13, 14 and 16-24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1795

/Anca Eoff/  
Examiner, Art Unit 1795

Continuation of 11, does NOT place the application in condition for allowance because: In regard to the rejection of claims 1, 10, 13-14, 16-18 and 20-24 under 35 USC 103 (a) as being unpatentable over Aoshima et al. (EP 1 235 107) in view of Aoshima et al. (US Patent 5,741, 619) and in further view of Iwamoto et al (US Patent 5,866,298), the applicant argues that Aoshima et al. (EP '107) relates to a planographic printing plate while Iwamoto et al. relates to a color filter, which is not required to have such high durability as a printing plate. The applicant further argues that if the organic acid of Iwamoto et al. would be added to a composition for planographic printing plates, the durability of the resulting printing plate would be decreased. However, the applicant is not showing any evidence in support of this argument.

The examiner would like to show the following: Aoshima (EP '107) teach a photopolymerizable composition comprising A) a polymerizable compound having at least one radical polymerizable ethylenically unsaturated double bond in the molecule, B) a radical polymerization initiator and C) a binder polymer (abstract, par.0010). The polymerizable compound A) is a radical-polymerizable compound having at least one, preferably two or more ethylenically unsaturated double bonds in the molecule (par.0015). The radical polymerization initiator may be a system comprising a hexaarylbiimidazole (par.0025). The binder C) is preferably a polymer having a carboxylic acid in the side chain thereof, to enable development in water (par.0035).

Aoshima et al. further disclose that the photopolymerizable composition is coated on a support (par.0066) and it is imaged/exposed using various light sources, such as UV light, electron rays, X rays (par.0078-0079) then is developed with an alkaline aqueous solution (par.0081).

Iwamoto et al. disclose a radiation sensitive composition comprising a binder polymer B), a polyfunctional monomer C) and a photopolymerization initiator D) (abstract). The binder polymer B) is preferably a copolymer made from a monomer mixture which contains an ethylenically unsaturated monomer with at least one carboxyl group (column 5, lines 4-12). The photopolymerization initiator D) contains as essential compound at least one biimidazole compound (column 7, lines 60-61) and one or more additives, such as other photo-radical generator, a sensitizer agent, a curing promoter may be used together with the biimidazole (column 10, lines 7-17).

Iwamoto et al. further disclose that the radiation sensitive composition is coated on a substrate, is exposed through a mask using radiation such as UV rays, electron beams, X rays and it is developed with alkaline solution (column 15, lines 12-54).

In the light of the facts shown above, it is the examiner's position that one of ordinary skill in the art would readily notice the similarities between the photosensitive composition of Aoshima (EP '107) and Iwamoto et al. and would have the motivation to combine their teachings.

Furthermore, Iwamoto et al. teach that an organic acid F) may be added to the radiation sensitive composition to improve the solubility in an alkaline developing solution and reduce residual insoluble matters after development when the binder polymer B) is a carboxyl-containing polymer (column 13, line 64-column 14, line 4). One of ordinary skill in the art would see the benefit of including such a compound in the photopolymerizable composition of Aoshima (EP '107), which comprises a binder with carboxyl groups in the side chain (par.0035) and it is developed in alkaline aqueous solutions (par.0081).

The applicant further argues that Aoshima et al. (US Patent 5,741, 619) do not use a polymerizable compound having at least one ethylenically unsaturated double bond in the working examples and concludes that Aoshima has a different image formation mechanism than Aoshima (EP '107) so one of ordinary skill in the art would not be motivated to combine their teachings. The applicant further argues that a binder polymer wherein R2 is a chain structure is not used in the working examples but merely described in the specification of Aoshima et al.

Aoshima et al. disclose a negative-working image recording material (abstract), said material comprising as binder material, an alkali-soluble binder which is easily removed by development with an alkali aqueous solution after exposure, such as an acrylic binder (column 4, lines 35-42). The acrylic resins are obtained by polymerizing at least one radical-polymerizable monomer of group A) with at least one radical polymerizable monomer selected from the groups B) and C) (column 9, lines 44-49). Group A) comprise monomers equivalent to the monomers of the binder of the instant application. While binders comprising such monomers are not shown in the working examples, they are clearly disclosed by Aoshima et al. so one of ordinary skill in the art would be motivated to use such monomers for an alkali-soluble binder.

The composition for the negative-working image recording material may also comprise a polyfunctional monomer having two or more radical polymerizable ethylenic double bonds in the molecule (column 12, lines 17-27). While Aoshima et al. do not give working examples of compositions including such polyfunctional monomers, it is very well-known in the art that such monomers are used in negative-working compositions.